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Paper No. 10

In re Application of :  
François Girard *et al* : DECISION ON PETITION  
Application No. 09/994,783 :  
Filed: November 28, 2001 :  
Attorney Docket No. P21643.A04 (S 878/US) :

This is a decision on the petition filed on October 28, 2003 by which petitioners request supervisory review and withdrawal of the a portion of the examiner's restriction requirement as promulgated on May 14, 2003 and made final on August 28, 2003. The petition is considered under 37 CFR 1.144, and no fee is required.

The petition is granted.

The restriction requirement in question is contested by petitioners with respect to claim groupings I, II and III. Inspection of the record shows that the examiner regards claim groupings I and II as being directed to "subcombinations usable together in a single combination", a type of "distinct inventions" discussed at MPEP 806.05(d). (See paper No. 6, page 3, paragraph 2.) Inspection of the record further shows that the examiner regards claim groupings I and III as being "unrelated" inventions. (See paper No. 6, page 3, paragraph 3.)

Claim 1 is a member of claim grouping I, and reads:

1. A sole for a boot, especially a sports boot, said sole comprising:  
a front portion and a rear portion more rigid in longitudinal bending than the front portion,  
at least one reinforcement in said portions,  
where:  
the front portion comprises a front half-sole affixed to the reinforcement;  
the rear portion comprises a rear half-sole affixed to the reinforcement; and  
the front and rear half-soles are assembled to one another in a junction zone, preferably, by  
cementing and/or riveting and/or welding.

Claim 8 is a member of claim grouping II, and reads:

8. A sole according to claim 1, wherein at least one of its front or rear portions is designed to cooperate with a sports apparatus.

Claim 12 is a member of claim grouping III, and reads:

12. A sole according to claim 1, wherein at least one of the front or rear (preferably front) half-soles is duplicate molded on the reinforcement, this duplicate molding being preferably selected from the moldable plastic materials, reinforced or non-reinforced, and having appropriate mechanical qualities for rigidity in the rear portion and flexibility in the front portion.

For the reasons set forth by petitioners, it is clear that the restriction requirement, whether as originally promulgated or as made final, is fundamentally flawed with respect to claim groupings I, II and III and is not in accordance with Office practice.


In accordance with petitioners' disclosed invention, claims 1 and 8 do not define subcombinations useable together. There is no disclosed invention comprising two soles, each formed from a front and rear half-sole and each having a reinforcement, with one sole having an element designed to cooperate with a

sports apparatus. The disclosed invention is a sole for boot that is formed of front and rear half-soles, each affixed to a reinforcement and to each other. According to the disclosures, the devices defined by claims 1 and 8 actually are related as subcombination/combination. However, the examiner's restriction requirement does not address the issue of whether, as claimed, these devices are distinct inventions in accordance with the instructions of MPEP 806.05(c).

With respect to the determination by the examiner that claims 1 and 12 define "unrelated" inventions, the examiner's citation of MPEP 806.04 and 808.01 as describing "unrelated inventions" may well be accurate, but the examiner's application of the teachings of these sections is not. The examiner's conclusory statements (paper No. 6, page 3, paragraph 3) simply are not supported by a reading of the disclosure. Claim 1, as reproduced above, defines a sole formed from two half-soles that are assembled to each other by a variety of techniques, and which are each attached to a reinforcement. Claim 12 merely requires that the manner in which at least one of the half-sole is attached to the reinforcement is that the half-sole is "duplicate molded on the reinforcement." See also the disclosure bridging pages 27 and 28 of petitioners' specification. The undersigned can discern nothing in the examiner's rationale supporting the restriction requirement which explains why the sole defined in claim 1 cannot be precisely the sole defined in claim 12. Clearly, the devices of claims 1 and 12 are not "unrelated" in the manner contemplated by MPEP 806.04, as a comparison of the examples in MPEP 806.04 with claims 1 and 12 clearly reveals.

In summary, the examiner's restriction requirement is clearly erroneous with respect to claim groupings I, II and III, and is hereby vacated and withdrawn. The application is being remanded to the Supervisory Applications Examiner of Art Unit 3728 with instructions to have the examiner take action not inconsistent with this decision. It appears to the undersigned that such action should take the form of examining the claims recited in claim groupings I, II and III.

PETITION GRANTED.



E. Rollins-Cross, Director, Patent  
Examining Groups 3710 and 3720

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